

REMARKS

This Amendment and Response is submitted in response to the Final Office Action mailed November 29, 2005.

*Formal Matters*

1. Applicant has amended claims 1-5, 11-15, and 28-31. Applicant has added new claims 45 and 46. Support for the amended and new claims are provided in paragraphs 18 and 19, and Figure 3 of the specification. Upon entry of the amendments, the application contains claims 1-46 pending and under consideration.
2. In accordance with 37 C.F.R. §1.114, Applicant hereby requests continued examination of the present application. The required fee as set forth in 37 C.F.R. §1.17(e) is included with the present submission.

*The Rejection of Claims Under 35 U.S.C. § 103(a)*

The Office Action rejects Claims 1, 2, 4-7, 10-12, 14-17, 20-22, 25-29, 31-34, 37-39, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0095745 to Wang (“Wang”) in view of U.S. Patent No. 1,031,024 to Pickles (“Pickles”).

The Office Action states that Wang discloses a telescoping handle for a transporting device having an external segment (30) with a hole (35) configured to receive a locking pin (22) and an inner segment (20) with the locking pin (22). The Office Action recognizes that Wang fails to teach a reinforcing mechanism. The Office Action states that Pickles teaches a material with a hole, where the hole includes a reinforcement

mechanism (12, 20). The reinforcing mechanism inherently distributes forces imparted by a member passing through it. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Wang as taught by Pickles, such that a reinforcement mechanism is included in the holes (35) of Wang, to prevent damage to the tube, or external member.

While Applicant respectfully disagrees with the Examiner regarding the teachings of Wang and Pickles, Applicant has amended independent claims 1, 11, and 28 to include additional limitations not taught in the prior art. More specifically, independent claims 1, and 11, and 28 each recite the following limitations not taught by Wang or Pickles:

“the reinforcing mechanism having a height substantially greater than a thickness of the external segment and residing flush with the internal surface of the external segment”

Wang teaches a retractable handle device for a suitcase with a microadjustable structure for adjusting to different lengths. The handle includes a pair of conduits (10) for attaching to the suitcase, a pair of tubes (20) slidably received within the conduits, and a pair of sleeves (30) received and engaged between the conduits (10) and the tubes (20). (23 and 24) Each sleeve (30) includes two semicylindrical members (300) and a number of holes (35) formed therein. The tubes (20) have one or more latches (21) each including one or more catches (22) for engaging through the holes (35) for adjustably securing the tube (20) to the sleeve (30) and subsequently to the conduit (10) for microadjusting the tube (20) relative to the sleeve (30) and the conduit (10). (25). Wang, however, has absolutely no disclosure regarding details of sleeve (30) surface design or construction, and is wholly unconcerned with the details of the holes (35) of the sleeve (30), merely stating the holes are “formed therein.” (*See Wang paragraph 25.*)

As the Examiner correctly observes, Wang does not disclose a reinforcing mechanism for the hole. It follows that Wang fails to disclose the claimed reinforcing mechanism having a height substantially greater than a thickness of the external segment and residing flush with the internal surface of the external segment.

Wang is deficient with respect to independent claims 1, 11, and 28 for at least the reasons stated above. Therefore, the Examiner must rely on Pickles to compensate for the foregoing deficiencies. Pickles describes a washer and a grommet provided within the washer. Pickles teaches the use of a grommet with the washer for setting in a sheet material, such as rubber goods, hammocks, awnings, and other textile articles.

The Applicant submits that Pickles fails to disclose the claimed reinforcing mechanism having a height substantially greater than a thickness of the external segment. As discussed above, and fully incorporated herein, Pickles is directed towards a washer that is substantially flat. The entire purpose of the washer disclosed in Pickles would be defeated if the length of the barrel [20] or flange [16] were made significantly longer so that the washer itself was not as flat as possible against the work [10]. To the contrary, the present invention is directed towards a reinforcing mechanism which has a height significantly greater than the external segment; the reinforcing mechanism is not intended to, and does not, remain as flat as possible against the exterior surface of the external segment. It follows that Pickles does not disclose the claimed reinforcing mechanism having a height substantially greater than a thickness of the external segment.

Finally, Pickles does not disclose the claimed reinforcing mechanism residing flush with the internal surface of the external segment. The Examiner argues that washer flange (12) and grommet barrel (20), which make up the reinforcing mechanism disclosed in Pickles, reside flush with the internal surface. (*See pg. 3, paragraph 6 of Office Action.*)

Applicants respectfully disagree. As disclosed in Fig. 3 of the present application, for the reinforcing mechanism to be flush with the internal surface, the bottom surface of the reinforcing mechanism must exist in the same plane as the internal surface of the external segment. The resulting combination of the reinforcing mechanism and the internal surface is a perfectly flat surface. Pickles explicitly states that the washer flange (12) "lies upon the surface of the work or may be slightly countersunk at its edges as shown in Fig. 2." (*See Pickles pg. 2, lines 65-67.*) Neither of these embodiments can be considered flush with the surface of the work. In the first embodiment, the washer flange is lying on the surface of the work, the top surface of the flange exists in the same plane as the surface of the work, but the bottom surface of the flange would extend above the surface of the work. The resulting combination cannot be considered perfectly flat. The second embodiment of the flange, when it is countersunk into the work at its edges, also fails to create a perfectly flat surface and cannot be considered flush with the surface of the work. The resulting combination of flange and work does create a flat surface up until the point where the flange is no longer countersunk in the work. After this point, the flange again lies on top of the surface of the work, and does not create a flat surface. Fig. 2 of Pickles, illustrating the second embodiment, exhibits the bottom plane of the work (10) with the edge of washer flange (12) countersunk into the work. At the point where the flange is no longer embedded, a lip is formed, and the flange's bottom edge exists on a plane different than that of the surface of the work. The bottom surface of combination of the work and washer flange is not, by any stretch of the imagination, perfectly flat. Accordingly, Pickles fails to disclose the claimed reinforcing mechanism residing flush with the internal surface of the external segment.

Since neither Wang nor Pickles teaches or suggests every element of amended claims 1, 11, or 28, Applicant respectfully submits that amended independent claims 1, 11, and 28, and the claims which depend from these independent claims are patentable over Wang further in view of Pickles.

Independent Claim 45

Independent claim 45 recites several limitations which are not disclosed by Wang nor Pickles. These limitations include:

“an exterior surface of the side wall having an annular raised lip extending along a periphery of the hole”

“an interior surface of the side wall having an annular recess along the periphery of the hole, the recess having a generally L-shaped cross-sectional contour taken along the plane extending through the longitudinal axis of the external segment,

“an annular washer positioned against the raised lip and having an outer perimeter with a radius substantially equal to the outer radius of the raised lip”

“the eyelet further having an inner portion extending into the recess of the interior surface of the side wall with an exposed face of the inner portion of the eyelet lying substantially flush with the inner face of the side wall;”

Neither Wang nor Pickles teaches or suggests these limitations.

Fig. 1 and Fig. 2 of Wang make it clear that the exterior surfaces of the sleeve (30) are completely flat, and have raised lips surrounding the holes (35). Accordingly, Wang fails to teach the claimed exterior surface having an annular raised lip

Pickles also fails to teach the claimed exterior surface comprising a raised lip surrounding the hole. Pickles has absolutely no disclosure regarding a raised portion of the work (10). Indeed, several stated objects of the invention, including “to provide a washer which shall present a flat and firm setting surface” (*See pg. 1, lines 83-85*), and “forming a flattened bead at the edge of the outer flange of the washer” (*See pg. 2, lines 20-22*), would

be defeated if a portion of the work was raised. Inspection of the work (10) found in Fig. 2 of Pickles reveals the exterior surface of the work has absolutely no raised portion, and remains completely flat except where the flange (18) is embedded. Accordingly, Pickles fails to disclose the claimed exterior surface comprising a raised lip surrounding the hole.

Fig. 1 and Fig. 2 of Wang also make it clear that the interior surfaces of the sleeve (30) are completely flat and have no recesses. Therefore, Wang does not teach an internal surface having an annular recess along the periphery of the hole where the recess has a generally L-shaped cross-sectional contour. Pickles also fails to disclose the claimed internal surface having an annular recess along the periphery of the hole where the recess has a generally L-shaped cross-sectional contour. Pickles discloses a work (10) that has a completely flat internal surface. However, the barrel of the washer (16) is countersunk in the work (10), resulting in the “rolled or clenched portion of the grommet barrel” lying below the surface of the work. (*See Pickles pg. 2, line 63-70*) Thus, the internal surface of the work itself does not have a recess, but rather a recess is created during the setting of the work. Even assuming, *arguendo*, that the work (10) surrounding the hole has a recess, the recess by countersinking the disclosed barrel could not be L-shaped, as claimed in the present invention. Pickles only discloses a rolled, rounded washer barrel (16). Countersinking this barrel could only result in a rounded recess, which is supported by Fig. 2 of Pickles. Pickles does not disclose a flat washer barrel that could possibly result in an L-shaped recess as disclosed in the present invention. Accordingly, Pickles fails to disclose the claimed internal surface comprising an L-shaped recess surrounding the hole.

Furthermore, because Wang and Pickles fail to disclose an exterior surface having a raised lip, it also follows that Wang and Pickles cannot disclose the claimed annular washer

positioned against the raised lip and having an outer perimeter with a radius substantially equal to the outer radius of the raised lip.

Finally, as discussed above, and fully incorporated herein, Wang does not disclose a reinforcing mechanism for a hole, and Pickles fails to disclose a reinforcing mechanism residing flush with the internal surface of the external segment. The eyelet, as disclosed in independent claim 45, is a required portion of the reinforcing mechanism. It follows that Wang fails to disclose the claimed eyelet, and that Pickles fails to disclose the claimed eyelet further having an inner portion extending into the recess of the interior surface of the side wall with an exposed face of the inner portion of the eyelet lying substantially flush with the inner face of the side wall.

Since neither Wang nor Pickles teaches or suggests every element of independent claim 45, Applicant respectfully submits that, at least for the reasons discussed above, independent claim 45 and the claim which depends from this independent claim are patentable over Wang further in view of Pickles.

*The Combination of Wang and Pickles was Improper*

Applicant also submits that the combination of Wang and Pickles to form the basis of a 35 U.S.C. § 103(a) rejection was improper. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed above, and fully incorporated herein, the washer flange (12) disclosed in Pickles does not reside flush to the internal surface of the work (10). Accordingly, if the washer disclosed in Pickles was combined with the telescoping handle disclosed in Wang, the result would be *an inoperative handle*. The bottom edge of tube (20) of Wang would collide with the protruding internal reinforcing mechanism of Pickles. The resulting handle would not be capable of telescoping and would completely defeat the purpose of the handle. Because the resulting combination of Wand and Pickles would render Wang inoperative and unsatisfactory for its intended purpose, the combination of Wang and Pickles to form a 35 U.S.C. § 103(a) rejection was improper. The Applicant thus requests that all rejections based on the combination of Wang and Pickles to be reconsidered and withdrawn.

CONCLUSION

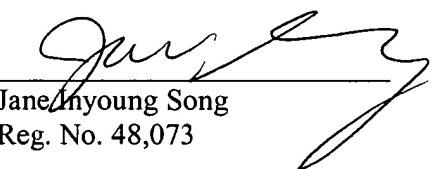
In view of the foregoing remarks, Applicant believes that the entire application is in condition for allowance and such action is respectfully requested. If it is believed that prosecution can be assisted thereby, the Examiner is invited to contact Applicant's undersigned representative at the below-listed telephone number.

Applicant hereby petitions for one-month extension of time up to and including March 29, 2006. Any required fee not submitted with this Amendment and Response is to be charged to Deposit Account No. 50-2613. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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